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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID JOSEPH GIMPL and
NEDZAD TALJANOVIC

Appeal 2016-006362
Application 13/739,141¹
Technology Center 2400

Before JASON V. MORGAN, BRUCE R. WINSOR, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to “configuring zoning within a switch of a storage network.” Spec. Abstract.

Illustrative Claim

Claim 1 is illustrative and reproduced below with the limitations at issue emphasized:

¹ According to Appellants, the real party in interest is International Business Machines Corporation. App. Br. 2.

1. A method for configuring zoning within a switch of a storage network, the method comprising:

providing, by at least one processor, a list of devices to a user, wherein the devices include at least one of server computers and storage devices;

enabling the user to select devices from the list and assign the devices to a zone of a storage network;

searching a device inventory database to determine which ports of a switch the devices are connected to;

determining port-to-port mappings needed to enable communication between the selected devices through the switch; and

sending a request to the switch to establish the zone with the determined port-to-port mappings.

Rejections

Claims 1–21 stand rejected under 35 U.S.C. § 101 as being directed to a non-patentable abstract idea. Final Act. 2.

Claims 1–21 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Graves (US 2006/0171384 A1; Aug. 3, 2006) and Bealkowski (US 2008/0028045 A1; Jan. 31, 2008). Final Act. 3.

ISSUES

1. Did the Examiner err in concluding claim 1 was directed to ineligible subject matter under § 101?

2. Did the Examiner err in finding the combination of Graves and Bealkowski teaches or suggests “enabling the user to . . . assign the devices to a zone of a storage network,” as recited in claim 1?

3. Did the Examiner err in finding Bealkowski teaches or suggests “searching a device inventory database to determine which ports of a switch the devices are connected to,” as recited in claim 1?

ANALYSIS

§ 101

The Examiner concludes the claims are not directed to patentable subject matter because they are “directed to an abstract idea” and “can be carried out on a generic computer.” Ans. 28–29.

To determine whether subject matter is patentable under 35 U.S.C. § 101, the Supreme Court has set forth a two part test. “First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts,” i.e., “laws of nature, natural phenomena, and abstract ideas.” *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). For computer-related technologies, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the *specific asserted improvement* in computer capabilities” (which would be eligible subject matter) or instead “on a process that qualifies as an ‘abstract idea’ for which *computers are invoked merely as a tool*” (which would be ineligible subject matter). *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36, 1338 (Fed. Cir. 2016) (emphasis added). For example, “adding conventional computer components to well-known business practices” would be ineligible subject matter. *Id.* However, one must keep in mind that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas,” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish*, 822 F.3d at 1337. Instead, “the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.”

Internet Patents Corp. v. Active Network, Inc., 790 F.3d 1343, 1346 (Fed. Cir. 2015). “If the claims are not directed to an abstract idea [or other patent-ineligible concept], the inquiry ends. If the claims are ‘directed to’ an abstract idea, then the inquiry proceeds to the second step of the *Alice* framework.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016).

In the second step, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78). The Supreme Court describes step two of this analysis as “a search for an inventive concept—i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *Id.* (quotation omitted).

“Distinguishing between claims that recite a patent-eligible invention and claims that add too little to a patent-ineligible abstract concept can be difficult, as the line separating the two is not always clear.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1255 (Fed. Cir. 2014). Moreover, recent cases suggest “there is considerable overlap between step one and step two.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). Nevertheless, regardless of which step is being examined, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen.” *Id.*

Here, the Examiner analogized the claims to *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014). Ans. 29. However, the Examiner’s reliance is misplaced

because the claims in that case “merely recite the use of this existing scanning and processing technology to recognize and store data from specific data fields such as amounts, addresses, and dates,” which was ineligible subject matter because “humans have always performed these functions” and “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Content Extraction*, 776 F.3d at 1347–48 (quoting *Alice*, 134 S. Ct. at 2358).

The claims here are different. The Federal Circuit has said a claim may pass the second step if “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *DDR Holdings*, 773 F.3d at 1257. Two examples of such eligible subject matter occur in *Amdocs* and *BASCOM*.

In *Amdocs*, the Federal Circuit held the claim was eligible subject matter because the claim

entails an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases). The solution requires arguably generic components, including network devices and “gatherers” which “gather” information. However, the claim’s enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality.

Amdocs, 841 F.3d at 1300–01.

The Federal Circuit reached a similar result with the abstract idea of “filtering content on the Internet” in *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016). “[T]he limitations of the claims, taken individually, recite generic computer, network and Internet components, none of which is inventive by itself,” but “an inventive concept can be found in the non-conventional and non-generic

arrangement of known, conventional pieces.” *Id.* at 1349–50. Put another way, “the ordered combination of these limitations provided the requisite inventive concept” to overcome the second step in *Alice/Mayo*. *Amdocs*, 841 F.3d at 1298–99 (summarizing *BASCOM*, 827 F.3d at 1347–51).

Here, we find the claims most analogous to *Amdocs* and *BASCOM*. Although the individual limitations recite generic components, such as “a switch,” “server computers,” and “storage devices,” the ordered combination of these limitations is directed to a specific technological solution to a specific technological problem, namely zoning devices in a storage network. This is “a challenge particular to” storage networks and sufficient to overcome the second step in the *Alice/Mayo* framework under § 101. *DDR Holdings*, 773 F.3d at 1257.

We note that we do not agree with the reasoning set forth in the Appeal Brief. The Supreme Court expressly rejected Appellants’ argument that merely adding “at least one processor” is sufficient to overcome § 101. *Alice*, 134 S. Ct. at 2358 (“the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention”); App. Br. 5. And contrary to Appellants’ assertion (App. Br. 6), the Examiner need not prove anticipation under § 102 or obviousness under § 103 in order to demonstrate ineligible subject matter under § 101, as those statutes are separate inquiries despite some potential overlap. *See Mayo*, 566 U.S. at 90. Nevertheless, in the interest of furthering prosecution, we apply § 101 as set forth in the intervening cases of *Amdocs* and *BASCOM*.

Accordingly, we do not sustain the Examiner’s rejection of claims 1–21 under § 101.

§ 103

A) “assign the devices to a zone”

Claim 1 recites “enabling the user to select devices from the list and assign the devices to a zone of a storage network.”

Appellants argue “[n]either Graves nor Bealkowski enable a user to directly assign server and/or storage system devices to a zone.” App. Br. 8. “Graves addresses verifying a zone configuration but does not appear to address how a zone is initially set up by a user,” and “Bealkowski does not appear to address network ‘zoning’ at all.” *Id.* at 8–9 (citation omitted).

However, we agree with the Examiner that “one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981); Ans. 30. Appellants have not sufficiently addressed the Examiner’s proposed combination. Ans. 29. Graves teaches “a properly bound disk LUN [logical unit] should always have a zone associated with it.” Graves ¶ 55; Ans. 31. Bealkowski teaches to “enable user to select . . . from list” a chassis, a computing device installed within the chassis, a switch connected to the computing device, and a storage device connected to the switch. Bealkowski Fig. 4A, ¶¶ 37, 40, 42, 44–46; Ans. 31. “It would be obvious in Graves, that a user/admin selects the devices for an initial setup of a VPN/group/zone” and “Bealkowski is brought in to teach the detail of the user being able to select devices.” Ans. 30. Regardless of whether Bealkowski’s “groups” are the same as the claimed “zones,” the Examiner’s findings show that it would have been obvious to apply (A) Bealkowski’s teaching of a user selecting devices to (B) the initial setup of Graves’ zones. The Examiner’s conclusion is further strengthened by Graves teaching that

“[g]enerally, data centers include technicians” (i.e., users) who “issue commands to control the deployment of servers and to control the supporting infrastructures, such as disk logical units (LUNs) in a disk array, network switches in the LAN, and switches in the SAN” (e.g., perform initial setup of devices). Graves ¶ 3; Ans. 30–31.

Thus, Appellants have not persuaded us the Examiner erred in finding Graves and Bealkowski teach or suggest “enabling the user to select devices from the list and assign the devices to a zone of a storage network.”

B) “ports”

Claim 1 further recites “searching a device inventory database to determine which ports of a switch the devices are connected to.”

Appellants contend the text of Bealkowski “doesn’t use the term ‘port’ anywhere,” and “[t]he only reference to a ‘port’ is in Figures 5E and 5J” which do “not describe what this ‘port’ refers to (i.e., whether it’s the port of the ‘*storage device*,’ [or] the port of a *switch* that the storage device is connected to, etc.).” App. Br. 10 (emphasis added); *see also* Ans. 33.

Bealkowski teaches “FIG. 5E shows a GUI 536 by which a user is able to select the SAN storage device 112 from all the SAN storage devices connected to the SAN *to which the switch 118 is connected.*” Bealkowski ¶ 45 (emphasis added). “A drop-down box 538 lists the network addresses of all the SAN storage devices connected to the SAN *to which the switch 118 is connected.*” *Id.* (emphasis added). “By selecting a given network address, information regarding the SAN storage device having this network address *is displayed in the boxes 540 and 542.*” *Id.* (emphasis added). As seen in Figure 5E, box 540 includes an entry for “Port.” Thus, the “Port” in Figure 5E is the port of the *storage device* selected by the user, not a *switch*.

Yet the Examiner's rejection was based on obviousness rather than anticipation. For obviousness, a factfinder "need not seek out precise teachings directed to the specific subject matter of the challenged claim" and "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). As discussed above, Bealkowski's storage device is connected to switch 118 (¶ 45), and Bealkowski teaches the list of storage devices available for selection is limited to those devices connected to the switch selected by the user. Bealkowski Fig. 4A, ¶ 44. Given Bealkowski teaches (A) selecting the storage device based on the user's selection of the switch and (B) tracking the port of the storage device, Appellants have not persuaded us that a person of ordinary skill in the art would not have found it obvious for Bealkowski to know and use the port of the switch connected to the storage device.

Accordingly, we sustain the Examiner's § 103 rejection of claim 1, and claims 2–21, which Appellants argue are patentable for similar reasons. *See App. Br. 11*; 37 C.F.R. § 41.37(c)(1)(iv) (2015).

DECISION

For the reasons above, we affirm the Examiner's decision rejecting claims 1–21 under § 103. We reverse the Examiner's decision rejecting claims 1–21 under § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED